

REMARKS

Claims 1-97 are pending in the application. In the Office Action mailed January 13, 2003, the Examiner required restriction of the invention under 35 U.S.C. § 121. The Examiner found the following 13 inventions:

- I. Claims 1-27, 30-63 in part, drawn to a compound wherein $X=O$, $n=0$, classified in class 549 subclass 387, and the composition thereof.
- II. Claims 1-26, 30-37, 40-55, 57-61 in part, drawn to a compound wherein $X=S$, $n=0$, classified in class 549, subclass 43, and the composition thereof.
- III. Claims 1-63 in part, drawn to a compound wherein $X=NR^{14}$, $n=0$, classified in class 546, subclass 85 and the composition thereof.
- IV. Claims 1-21, 23-53, 55-63 in part, drawn to a compound wherein $X=O$, $n+1$, classified in class 549, subclass 388, and the compositions thereof.
- V. Claims 1-21, 23-26, 30-38, 40-53, 55, 57-61 in part, drawn to a compound wherein $X=S$, $n=1$, classified in class 549, subclass 26, and the composition thereof.
- VI. Claims 1-21, 23-53, 55-63 in part, drawn to a compound wherein $X=NR^{14}$, $n=1$, classified in class 546, subclass 88, and the compositions thereof.
- VII. Claims 1-20, 23-38, 40-53, 55-62 in part, drawn to a compound wherein $X=O$, $n=2$, classified in class 549, subclass 354, and the composition thereof.
- VIII. Claims 1-20, 23-26, 30-38, 40-53, 55, 57-62 in part, drawn to a compound wherein $X=S$, $n=2$, classified in class 549, subclass 12, and the composition thereof.
- IX. Claims 1-20, 23-38, 40-53, 55-62 in part, drawn to a compound wherein $X=NR^{14}$, $n=2$, classified in class 540, subclass 580, and the composition thereof.

- X. Claims 64-94, drawn to a method of treating an individual having a condition mediated by an androgen receptor.
- XI. Claim 95, drawn to a method of treating cancer.
- XII. Claim 96, drawn to a method of determining the presence of an androgen receptor in a cell or cell extract.
- XIII. Claim 97, drawn to a method for purifying a sample containing an androgen receptor in vitro.

Applicants hereby provisionally elect the invention of Group III, with traverse. Applicants reserve their right to prosecute the non-elected subject matter in this application or in a divisional application. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

In the Office Action mailed January 13, 2003, the Patent Office argued that “compounds of Groups I to IX are structurally and patentably distinct as they have acquired a separate status in the art as shown by their different classification. A reference anticipating the group I invention would not rendered [sic] obvious the compounds of the other groups.” (Office Action mailed January 13, 2003, p.3). For the following reasons, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

M.P.E.P. § 803 states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions.” Applicants respectfully submit that, given the common utility and structural features of the claimed compounds, a search and examination of the entire application would not pose a serious burden on the Examiner.

Even if the Examiner insists that a search and examination of the entire application would necessarily impose an undue burden on the Examiner, Applicants respectfully submit that the corresponding subject matter of Groups X through XIII should be grouped with each of Groups I

through IX. For example, as applied to Applicants' election of Group III, Applicants respectfully submit that the subject matter of Groups X through XIII that corresponds to the subject matter of Group III should be grouped with Group III. In other words, Applicants respectfully submit that it would not pose an undue burden on the Examiner to search and examine, in addition to the compounds of Group III, those portions of claims 64-97 that are drawn to use of a compound of Group III (i.e., $X=NR^{14}$, $n=0$).

In addition to the aforementioned restriction requirement, the Examiner requested that Applicants elect a species within the elected species for examination. Applicants hereby provisionally elect Compound 153, which is 6-Ethyl-5-methyl-7-(2,2,2-trifluoroethyl)-4-trifluoromethyl-7H-pyrrolo[3,2-f]quinolin-2(1H)-one. Compound 153 is disclosed in the specification, for example, at pages 28, lines 24-25, at page 34, lines 17-18, and in Example 53 at page 68. At least claims 1-2, 4-11, 18-19, 21-22, 27-38, 40-49, 53-54, 56-66, and 73-97 read on the elected species.

Conclusion

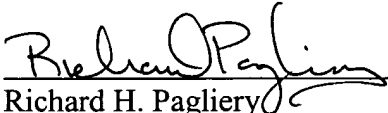
For the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the outstanding restriction requirement. The Commissioner is hereby authorized to charge \$930.00 to our Deposit Account No. 50-2613 for the fee required under 37 C.F.R. §1.17(a)(3) for a three-month extension of time. The Commissioner is also authorized

to charge any additional fees required by this response, or credit any overpayment, to our
Deposit Account.

Respectfully submitted,

Dated: May 13, 2003

By:


Richard H. Pagliery
Reg. No. 44,276

Paul, Hastings, Janofsky & Walker, LLP
12390 El Camino Real
San Diego, CA 92121
Telephone: (858) 720-2500
Facsimile: (858) 720-2555